

REMARKS**Rejection of claims 87-89 under 35 U.S.C. § 112, second paragraph**

The Office rejected claims 87-89 as indefinite. The claim dependency has been amended as suggested by the Office, thereby obviating this rejection.

Rejection of claims 73-96, 100, and 112 for obviousness-type double patenting

The Office rejected claims 73-96, 100, and 112 for obviousness-type double patenting over claims 1 and 8 of US 6,235,973. The applicants herewith submit a terminal disclaimer, thereby obviating this rejection.

Rejection of claims 73-75, 85, 95-96, and 100 under 35 U.S.C. § 102(e)

The Office rejected claims 73-75, 85, 95-96, and 100 as anticipated by Smith (US 5,945,579). For the reasons described below, the applicants respectfully traverse.

Smith cannot anticipate the rejected claims because it is a non-enabling reference. It is well settled that for a prior art publication to anticipate a claim that publication must enable one of ordinary skill in the art to practice the invention.

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

MPEP § 2101.01.

When the claims are drawn to plants, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962)

MPEP § 2121.03. Smith does not provide an enabling disclosure and, therefore, cannot anticipate the present claims.

Smith is directed to

transgenic plants expressing a phytochrome A coding sequence (or biologically active fragment or analogue thereof) which exhibit substantially the same growth pattern and plant